



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/762,937

01/21/2004

Alexander G. MacInnis

51706/JEJ/B600

5694

23446

7590

07/17/2007

MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED: 07/17/2007

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|--|--------------------------------------|--|--|
| Notification of Non-Compliant Appeal Brief (37 CFR 41.37) | Application No. 10/762,937 | Applicant(s) MACINNIS ET AL. | |
| | Examiner Jeffery A. Brier | Art Unit 2628 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 02 April 2007 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.

EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.

1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☒ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☒ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner **and relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

see page 2.

/Jeffery A. Brier/
Primary Examiner, Division 2628

1. The Appeal Brief is additionally defective for the following reasons:

The summary of the invention and the arguments refer to the specification by paragraph numbers while the specification does not have any paragraph numbers.

The arguments do not treat each ground of rejection separately under a separate heading instead appellant argues the 112 first and second paragraph rejections together rather than separately. See MPEP 1205.02 at page 1200-15 first column.

The evidence appendix and the related proceedings appendix do not use the word "none". See MPEP 1205.02 at page 1200-15 second column.

2. Appellant should note MPEP 1205.03 at page 1200-16 second column first paragraph which states "The appeal will be dismissed if the appellant does not timely file an amended brief, or files an amended brief which does not overcome all the reasons for noncompliance of which the appellant was notified." See also MPEP 1215.04 at page 1200-64 second column second paragraph which states with regard to dismissed appeals "Applications having no allowed claims will be abandoned."

3. Re the argument at page 8 first full paragraph note the following CAFC decision DECIDED: June 18, 2007 at <http://www.fedcir.gov/opinions/06-1350.pdf> and at 83 USPQ2d 1118:

2006-1350
BIOMEDINO, LLC,
Plaintiff-Appellant,
v.
WATERS TECHNOLOGIES CORPORATION,
Defendant-Appellee,
and
GENERAL ELECTRIC COMPANY (doing business as GE Healthcare),
Defendant-Appellee,
and
AGILENT TECHNOLOGIES, INCORPORATED

Art Unit: 2628

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:30 to 4:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (571) 272-7664. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffery A. Brier/
Primary Examiner, Division 2628